

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: Xiaodong Jin et al.	Art Unit	: 2836
Serial No.	: 10/811,031	Examiner	: Scott Allen Bauer
Filed	: March 26, 2004	Conf. No.	: 1354
Title	: METHOD AND APPARATUS FOR IMPROVING SUPPLY NOISE REJECTION		

Mail Stop Appeal Brief - Patents

Commissioner for Patents
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REPLY BRIEF

This Reply Brief is filed in response to the Examiner's Answer dated August 5, 2008.
Pursuant to 37 C.F.R. § 41.41, Applicant responds to the Examiner's Answer as follows:

1. On page 14, ¶ 2, with respect to independent claims 1, 9, 17, 24, and 31 in view of Jenkins in combination with Duclos, the Examiner asserts that:

Initially, it is pointed out that the embodiment of Jenkins' Fig. 3 is not relied upon and only the embodiment found in [Jenkins'] Fig. 1 is used to reject all currently rejected claims. . .

Applicants respectfully submit that the Examiner misunderstands the import of Applicants' arguments with respect to Fig. 3 of Jenkins. The Examiner rejected Applicants' claims 1, 9, 17, 24, and 31 under 35 U.S.C. § 103(a), relying on the protection circuit shown in Jenkins' Fig. 1. The Examiner acknowledged that Jenkins' Fig. 1 fails to show Applicants' claimed ESD clamp directly coupled between a high voltage supply and a low voltage supply. However, the Examiner asserted that Duclos teaches an ESD clamp coupled between high and low voltage supplies and that it would have been "obvious to one of ordinary skill in the art" to incorporate Duclos' ESD clamp into Jenkins' design. (*See* Answer at p. 5, ¶ 3). The Examiner's rejection is thus dependent upon the existence of a reasonable rationale for combining Duclos' ESD clamp with Jenkins' circuit.

Applicants' position with respect to Jenkins' Fig. 3 is that this figure negates any such reasonable rationale. Specifically, as Applicants discuss in their Appeal Brief, Jenkins knew about the technique of using an ESD clamp to protect against electrostatic discharge. In fact,

Jenkins uses this same ESD clamp in the embodiment of Jenkins' protection circuit shown in Fig. 3. Jenkins consciously rejected the inclusion of an ESD clamp – i.e., rejected the element of Duclos the Examiner now seeks to add – in favor of a different design. Jenkins therefore teaches away from the Examiner's combination. *See, e.g., In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference. . . would be led in a direction divergent from the path that was taken by the applicant.”); *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1740 (2007) (noting the “principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious”). Certainly, it cannot be said that a combination is “obvious to one of ordinary skill in the art” when the named inventor of the Examiner's primary reference, one of ordinary skill in the art, rejected such a combination.

It is improper to combine references when the references themselves teach away from the combination. *See* MPEP § 2145.X.D.2 (*citing In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983)). Consequently, the Examiner's proposed combination of Jenkins and Duclos is improper. Applicants respectfully submit that claims 1, 9, 17, 24, and 31, and all claims depending from any of claims 1, 9, 17, 24, and 31, are allowable for at least these reasons.

2. On page 14, ¶ 2-page 15, ¶ 1, with respect to independent claims 1, 9, 17, 24, and 31 in view of Jenkins in combination with Duclos, the Examiner asserts that:

The clamp of Fig. 3 of Jenkins contains two deficiencies compared to the clamp of Duclos. . . By placing the clamp of Duclos between the VDD and VSS lines of Jenkins' Fig. 1, both of these problems are solved. . . In no embodiment does Jenkins disclose bidirectional protection between VDD and VSS and thus, one of ordinary skill in the art interested in protection against both positive and negative ESD events occurring from the positive rail to the negative rail would have been motivated to combine the two references as described.

In his Answer, the Examiner focuses considerably on the ways in which his proposed combination would solve the “deficiencies” contained in Jenkins' ESD clamp. These “deficiencies,” though, are merely the ways in which Jenkins fails to solve the problem addressed by Applicants' claimed invention – that is, the ways in which Jenkins' design fails to provide bidirectional protection from both positive and negative ESD events. The Examiner's

argument is essentially a *non sequitur*: that because Jenkins failed to solve the problem addressed by Applicants using the same design chosen by Applicants, it would have been obvious to hand-pick the ESD clamp from Duclos to do so.

The Examiner's rationale is a straightforward example of "defining the problem in terms of its solution" and is the very mark of hindsight. *See, e.g., Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998) ("Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness."); *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991) ("It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps."). The relevant inquiry under 35 U.S.C. § 103 is not simply whether or why Duclos' clamp improves upon Jenkins with respect to solving the problem addressed by Applicants, but whether a reasonable rationale exists for combining the two references. As Applicants have discussed above, no such rationale exists. Applicants respectfully submit that claims 1, 9, 17, 24, and 31, and all claims depending from any of claims 1, 9, 17, 24, and 31, are allowable for at least these additional reasons.

For at least these reasons, as well as the reasons stated in the Appeal Brief, Applicants submit that the final rejection should be reversed.

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Respectfully submitted,

Date: October 6, 2008

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